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EXAMINER

BLAKE, CAROLYN T

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8N

<b>Office Action Summary</b>	<b>Application No.</b> 10/612,773	<b>Applicant(s)</b> PORTNOY, ARKADY	
	<b>Examiner</b> Carolyn T Blake	<b>Art Unit</b> 3724	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 12, 15, and 177 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 11-16 in the reply filed on November 22, 2004 is acknowledged. The traversal is on the ground(s) that there is no added burden on the Examiner in the search and examination of the additional species. However, for a proper traversal, Applicant is required to submit evidence or admit on the record that the species are obvious variants of each other. Applicant has not done this.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 29 (FIG 11), 34 (FIGS 8 and 13), and 35 (FIG 14). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The disclosure is objected to because of the following:
- Page 15, lines 11-12: "this alternate embodiment show" should be changed to - -this alternate embodiment showing- -.
  - Page 16, line 8: the reference character "26" is incorrect.

Appropriate corrections are required.

***Claim Objections***

4. Claim 15 appears to be an exact duplication of claim 13. Claim 15 should be deleted.
5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 16 has been renumbered 17.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 11, 14, 16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 11 recites the limitation "the principal rotational axis" in line 8. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 14 recites the limitation "the dispensing system" in line 25. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 14 recites the limitation "the principal rotational axis" in line 32 of page 22 to line 1 of page 23. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 16 recites the limitation "the second cover" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 16 recites the limitation "the second stationary cover" in lines 14-15. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 16 recites the limitation "the second tray" in lines 18. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 17 recites the limitation "the second dispenser" in line 22. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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16. Claims 11 is rejected under 35 U.S.C. 102(e) as being anticipated by McElhinny (6,749,097 B1). McElhinny discloses a dispenser (FIGS 1-18) comprising: a first dispenser, wherein the first dispenser comprises: first tray (22) having an arcuate section (75) for receiving a roll of sheet material; a first cover (52), having a front edge and a back edge, with an offset pivot point (58) above the principal rotational axis of the first tray (22) wherein a first cutting surface (62) fixedly attached to the front edge and the first cover is operably mounted within a first stationary cover (28).

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over McElhinny as applied to claim 11 above, and further in view of Haley (3,028,060). McElhinny fails to disclose the first tray comprises apertures. Haley discloses a dispenser comprising a tray with apertures (18) for digitally contacting received sheet material (9). See FIGS 2-4. The apertures allow a user to easily remove sheet material from the dispenser (col. 2, lines 3-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide apertures in the tray, as disclosed by Haley, on the McElhinny device for the purpose of easily removing the sheet material.

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19. Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McElhinny as applied to claim 11 above, and further in view of Botnick (2,969,169).

Regarding claim 14, McElhinny fails to disclose a second dispenser. However, Botnick discloses a dispensing system (10) comprising: a first and second dispenser (FIGS 1-3) wherein the second dispenser comprises: a second tray, a second cover (21), having a front edge and a back edge, wherein a second cutting surface (20) is fixedly attached to the front edge and the first cover is operably mounted within a first stationary cover (11-15). The addition of a second dispenser allows a user to store different varieties of sheet material in the same dispenser (col. 1, lines 22-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a second dispenser, as disclosed by Botnick, on the McElhinny device for the purpose of storing different varieties of sheet material in the same dispenser.

Regarding claim 17, the McElhinny and Botnick combination would be oriented in a horizontal orientation if the device were rotated 90 degrees. The device would still operate in this position.

***Allowable Subject Matter***

20. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ramsey (851,835) discloses a dispenser with a cover comprising a slot. Lewis et al (2003/0019971 A1) disclose a dispenser comprising a cover with a slot for receiving a tab extension.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 13, 2004



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